

REMARKS

Claims 7-12 are pending in the present application. None of the claims were amended in this response. Favorable reconsideration is respectfully requested.

Claims 7-12 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Bae et al.* (U.S. Pub. 2004/0203496) in view of *Bank et al.* (US Pub. 2003/0059069). Applicant respectfully traverses these rejections.

Specifically, the prior art, alone or in combination does not teach or suggest the features of “a first and a second housing part, wherein each part can be displaced with respect to one another in such a way that respective sections of each housing part are exposed as a result of the displacement, wherein one of the exposed sections is at least partially in the form of a bending wave loudspeaker comprising a plate-like element for emitting audible signals and an operating element for exciting bending waves in the plate-like element” as recited in claim 7. Under the recited configuration, the resulting telephone structure addresses the situation, where during displacement of typical “slider” phones, a protective window has to assume the functions of mechanically protecting the interior of the displaced mobile telephone and has to be transparent, where the selection of materials for the protective window is limited and cannot be optimized, in particular for the function of the protective window as a bending wave loudspeaker.

The Bae document merely discloses a conventional “slider” phone, where the displacement of the upper (20) and lower (10) housing creates an exposed section (see FIG. 2) that only contains an upper solid surface (10a) and key pad (12). Nowhere in Bae does the document disclose that one of the exposed sections is at least partially in the form of a bending wave loudspeaker. To the contrary, Bae clearly teaches that

A key pad 12 including a plurality of keys is formed on the upper surface 10a of the main housing 10, and a microphone unit 14 is installed on an upper surface 16a of the protrusion 16 of the main housing 10. A speaker unit 22 and a wide LCD (Liquid Crystal Display) 24 is formed on an upper surface 20a of the sliding housing 20.

See FIG. 2 and paragraph [0025]. Thus, the speaker is arranged entirely on the upper surface, and is not in the exposed section. Furthermore, the entire disclosure of Bae does not

even contemplate such an arrangement, and instead addresses a sliding-type mobile phone that can be opened or closed with a minimum of force (see ([0010, 0036])).

Bank also does not solve the deficiencies of Bae, discussed above. Bank teaches a bending wave loudspeaker including a transparent acoustic radiator ([0040, 0081]) and an operating element for exciting bending waves ([0061, 0078]). However, the disclosure of Bank teaches that the loudspeaker may be incorporated in a telephone handset via a display window (see FIG. 1, [0053-56]). Again, Bank fails to teach or suggest a structural arrangement where the loudspeaker is arranged in an exposed section of a sliding-type telephone. Referring back to the Bae document, the disclosure teaches that both the display and speaker are contained on one surface that is not exposed through displacement ([0025], see above).

Furthermore, there is no teaching, suggestion or motivation for one of ordinary skill in the art to combine the *Bae* and *Bank* references in the manner suggested in the Office Action. In making a determination that an invention is obvious, the Patent Office has the initial burden of establishing a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). "If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). (see MPEP 2142).

Further, the Federal Circuit has held that it is "impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Moreover, the Federal Circuit has held that "obvious to try" is not the proper standard under 35 U.S.C. §103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). "An-obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such

that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claim result would be obtained if certain directions were pursued.” *In re Eli Lilly and Co.*, 14 U.S.P.Q.2d 1741, 1743 (Fed. Cir. 1990).

Regarding *Bae*, the screen and speaker components are contained on a non-exposed single surface of the sliding-type phone. Bank does not provide any teaching, suggestion or motivation for configuring the speaker on an exposed section of a sliding-type telephone. For at least these reasons, Applicant respectfully submits the rejection is improper and should be withdrawn. Accordingly, Applicants respectfully request that a timely Notice of Allowance be issued in this case. If any additional fees are due in connection with this application as a whole, the Examiner is authorized to deduct such fees from deposit account no. 02-1818. If such a deduction is made, please indicate the attorney docket no. (117393-026) on the account statement.

Respectfully submitted,

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